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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,103	01/19/2001	Kenichi Kurata	Q62224	4519
7590	08/01/2006		EXAMINER	
SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC 2100 Pennsylvania Ave., N.W. Washington, DC 20037			LASTRA, DANIEL	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 08/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/764,103	KURATA ET AL.
	Examiner	Art Unit
	DANIEL LASTRA	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 June 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 6-8,12-14,16,18,19,22,23,30,31,34,35,53,55 and 57-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 6-8,12-14,16,18,19,22,23,30,31,34,35,53,55 and 57-84 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>06/16/2006</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35, 53, 55 and 57-84 have been examined. Application 09/764,103 (Image-forming system employing a cartridge and providing a benefit to a user) has a filing date 01/19/2001 and claims foreign priority# 2000-014050 (01/19/2000).

Response to Amendment

2. In response to Non Final Rejection filed 02/07/2006, the Applicant filed an Amendment on 05/05/2006, which amended claims 53, 55, 69-71, 75, 77, cancel claims 54, 56 and added new claims 80-84.

Claim Objections

3. Claims 83 and 84 are objected to because of the following informalities: Claim 83 recites at the last line "first an second computer program" when it should recite "first and second computer program". Claim 84 recites "determining" where it should recite "determine". Appropriate correction is required.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6-8, 12, 13, 14, 16, 18, 19, 22, 23, 30, 31, 34, 35, 57-68 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (US 6,405,214) in view of Helterline et al (U.S. 6,039,430) and further in view of Goodwin (US 4,203,240).

As per claims 6-8, 12, 13, 18, 19, 22, 23, 30, 31, 34, 35, 57-68 and 79 Meade teaches:

An image-forming system employing a host apparatus and an image-forming apparatus which are mutually connected, comprising:

a component that determines whether something has been won in connection with use of the image-forming apparatus or the host apparatus, and reads the prize data from the memory element and uses the prize data to award a prize to a user when the results of that determination indicate that something has been won, as a result of which the user is made able to receive the prize. Wherein the prize data comprises at least one species selected from among the group consisting of image data serving as prize itself, image-forming apparatus driver information serving as a prize itself, a keyword or password which must be supplied to a prescribed prize awarding organization in order to obtain a prize, and a URL of a network site which awards a prize (see Meade column 5, lines 1-20).

prize awarding component that performs processing for awarding a prize to a user in correspondence to the usage data read by the reading component (see Meade col 5, lines 15-20)

Meade fails to teach:

a replaceable cartridge possessing a memory element being installed in the image forming apparatus. However, Helterline teaches a replaceable cartridge possessing a memory element being installed in the image forming apparatus (see Helterline figure 2A, item 38; column 8, lines 59-65).

Meade fails to teach and lottery determination data for determining whether something has been won being stored in the memory element; a reading component for reading the lottery determination data from the memory element; a lottery determination component that uses lottery determination data read by the reading component to determine whether something has been won; and a prize awarding component that performs processing for awarding a prize to a user in correspondence to the results of a determination carried out by the lottery determination component when the results of such determination indicate that something has been won and prize data, being a prize itself or data for obtaining a prize from a prescribed prize awarding organization, being stored in the memory element, as a result of which the user is made able to receive the prize upon exchange of the cartridge thereof. However, Goodwin teaches a method for inducing consumers to return any container of all sorts, which may be reused, recycle or that is desirable to have returned to certain locations for whatever reason. Said method involves the placement of identifying indicia in any container, so when said container is returned to the designated place, a lottery-type drawing may be held of those indicia bearing segments, which have been returned, where the user with the winning indicia would claim the prize associated with the winning lottery (see Goodwin col 1, lines 45-60; col 4, lines 15-23). Therefore, it would have been obvious to a person of ordinary

skill in the art at the time the application was made, to know that users of the Meade system would be motivated to return empty printers' toner cartridges to a redemption center, as taught by Goodwin in view that the identifying indicia of said toners' cartridges obtained from said cartridges' memory (*i.e.* toner's cartridge identification number)¹, as taught by Helterline would allow said users to participate in a lottery-type drawing, which would allow said users to win prizes, as taught by Goodwin.

As per claims 14 and 16, Meade does not expressly teach the image-forming system according to claim 13 further comprising a component for preventing repeated awarding of prizes based on the same usage data in connection with the same cartridge. However, Goodwin teaches a method which involves the placement of identifying indicia in any container, so when said container is returned to a designated place, a lottery-type drawing may be held of those indicia bearing segments, which have been returned, where the user with the winning indicia would claim the prize associated with the winning lottery (see Goodwin col 1, lines 45-60; col 4, lines 15-23). Official Notice is taken that it is old and well known that lottery drawings have fraud control measures to prevent repeated awarding of prizes to the same user of a winning lottery number. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would provide an incentive to encourage users to return empty printers' toner cartridges, as taught by Goodwin by allowing said users to participate in lottery drawings using the toners' cartridge identification data (*i.e.* usage data or identification number) stored on said toners'

¹ Helterline col 5, lines 35-41

cartridges memory, as taught by Helterline and said lottery drawings would have fraud control measures to avoid that the same user receives repeated prizes for returning the same toner's cartridge which has a winning indicia.

As per claim 79, Meade teaches:

A method for providing a benefit, comprising the steps of writing a user ID for specifying a user to a memory element which has a cartridge ID stored therein, the memory element being possessed by the cartridge attached to the image forming apparatus (see column 5, lines 5-20);
acquiring the user ID and the cartridge ID from the memory element of a recovered cartridge (see column 5, lines 5-20);

Meade fails to teach increasing a point value corresponding to the acquired user ID by using a point value corresponding to the acquired cartridge ID; and providing a user specified by the acquired user ID with a benefit when the increased point value exceeds a predetermined threshold value. However, Goodwin teaches a method which involves the placement of identifying indicia in any container, so when said container is returned to the designated place, a lottery-type drawing may be held of those indicia bearing segments, which have been returned, where the user with the winning indicia would claim the prize associated with the winning lottery (see Goodwin col 1, lines 45-60; col 4, lines 15-23). Helterline teaches an apparatus for retrieving information on a replaceable printing component (see column 2, lines 1-20). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would be motivated to encourage users to return empty

toners' cartridges as said users would be allowed to participate in a lottery-type drawing for said returning, as taught by Goodwin and where points would be given as prizes which can be redeemed for products when said points reach a threshold amount (*i.e.* food)². This feature would provide another incentive to encourage users to return empty toner's cartridges as said users would receive points for said returning which can redeem for products.

5. Claims 53, 55, 73, 74, 69-72 and 75-82 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meade (US 6,405,214) in view of Helterline et al (U.S. 6,039,430) and further in view of Hayward et al (U.S. 6,629,134).

As per claims 53 and 55, Meade teaches:

A system which uses a host apparatus and image-forming apparatus that are connected to each other and a server to which the host apparatus is communicably connected, wherein:

a URL for the server and a password for permitting access to the server are stored in the memory element of the cartridge; the image-forming apparatus comprises a first reading component for reading the URL from the memory element of the cartridge, and a second reading component for reading the password from the memory element of the cartridge; and the host apparatus comprises an access component for accessing the server indicated by the URL by using the URL, and a password-transmitting component for transmitting the password inside the memory element of the cartridge, which has been read by the second reading component of the image-forming

² Meade col 3, lines 10-20

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apparatus, to the server in response to an inquiry sent from the server, thereby connecting to the server (see Meade column 2, lines 15-25; column 5, lines 4-20). Meade fails to teach a replaceable cartridge with a memory element is attached to the image-forming apparatus. However, Helterline teaches a replaceable cartridge with a memory element (see Helterline figure 2A, item 38; column 8, lines 59-65);

Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline and Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

Meade teaches wherein an ID of the cartridge is also stored in the memory element of the cartridge, the server has a web page corresponding to the cartridge ID and for providing sample printing data, the image-forming apparatus further comprises a third reading component for reading the cartridge ID from the memory element of the cartridge (see column 5, lines 5-20), and

Meade fails to teach the host apparatus further comprises a printing data access component for automatically accessing the web page corresponding to the ID which is in the memory element of the cartridge and has been read by the third reading

component of the image-forming apparatus. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

As per claims 69, 71, 75-78, Meade teaches:

A method for providing information online from an information-providing server in response to a request from a client who has an image-forming apparatus attached replaceably to a cartridge, the method comprising:

transmitting information *including the first resource information and the second resource information and indicating a printing environment to the information-providing server* (see column 5, lines 5-20);

transmitting a software for control, which is used when the client performs printing using the cartridge, to the client on the basis of the information indicating a printing environment which is transmitted from the client (see column 5, lines 5-20); and

Meade fails to teach *acquiring a first resource information in connection with a resource of the client from a storage resource in the client; acquiring a second resource information which is in connection with a resource of the image-forming apparatus and read from a storage resource from the image-forming apparatus; updating software*

which requires to be updated to the software for control which has been received from the information-providing server. However, Helterline teaches a printer cartridge memory which stores the printer driver version number and the updating of said driver in the event that printing parameters changes during operation of the printing system (see Helterline col 6, lines 30-55). Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 5, lines 55-65; col 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward in order to update the printer drivers or other parameters and ensure that the printing system prints the highest quality images, as taught by Helterline.

As per claim 70, Meade teaches:

The method according to claim 69, but fails to teach wherein *the first resource information includes at least a version of a printer driver in the client; the second resource information includes at least a version of a firmware in the image-forming apparatus*; the software for control is at least one of a printer driver and a printer firmware that are used when performing printing using the cartridge. However, Helterline teaches a system which stores the printer driver version number in a printer cartridge memory and updates said printer driver in the event that printing parameters changes during operation of the printing system (see Helterline col 6, lines 30-55). Hayward teaches a system that detects computers' peripherals conditions and provides

user support based upon said detection (see column 5, lines 55-65; col 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward in order to update the printer drivers or other parameters and ensure that the printing system prints the highest quality images, as taught by Helterline.

As per claim 72, Meade teaches:

The method according to claim 71, but fails to teach wherein the cartridge is provided with a memory element, an ID of the cartridge is stored in the memory element of the cartridge, and the information-providing server has a web page corresponding to the cartridge ID and for providing sample printing data, the method further comprising:

reading the ID of the cartridge from the memory element of the cartridge, and automatically accessing the web page corresponding to the ID of the cartridge which is in the memory element of the cartridge and has been read by the image-forming apparatus. However, Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward. In this way the information provided is not only

specific to the product configuration of the peripheral as it exists in the product's life cycle, but also specific to the peripheral condition sensed.

As per claim 73, Meade teaches:

The information-providing method according to claim 69 or 71, but fails to teach wherein the cartridge is provided with a memory element, and a URL for the information-providing server and a password for permitting access to the information-providing server by the client are stored in the memory element, the method further comprising: reading the URL from the memory element of the cartridge, using the URL to access the information-providing server indicated by the URL, reading the password from the memory element of the cartridge, and transmitting the password inside the memory element of the cartridge, which has been read by the image-forming apparatus, to the server in response to an inquiry sent from the information-providing server, thereby connecting to the server. Meade teaches a system that uses cookies, which contains passwords and users' ID, to allow users to log in to third-party websites to transmit the users' printing profile data (see Meade column 2, lines 15-25; column 5, lines 4-20). Helterline teaches a replaceable cartridge with a memory element (see Helterline figure 2A). Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline and Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target

promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

As per claim 74, Meade teaches:

The information-providing method according to claim 73, but fails to teach wherein a range of permitting the access in the information-providing server is set to a range, which is different depending on the password. However, Official Notice is taken that it is old and well known in the computer art that different password allow different range of access to data. Meade teaches a system that uses cookies, which contains passwords and users' ID, to allow users to log in to third-party websites to transmit the users' printing profile data (see Meade column 2, lines 15-25; column 5, lines 4-20). Hayward teaches a system that detects users' computers peripherals conditions and provides to the users support information based upon said detection (see Hayward column 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server users' computer peripheral conditions for the purpose of transmitting to the users support information and target promotions, as taught by Hayward. In this way the information provided is not only specific to the product configuration of the peripheral as it exists in the product's life cycle, but also to the peripheral condition sensed.

As per claim 80, Meade fails to teach the method according to claim 69, wherein the first resource information includes version of a operating system in the client and a

value for free space in storage resource in the client; the second resource information includes version of a firmware in image-forming apparatus and a value for free space in storage resource in the image-forming apparatus; determining whether an update of the software for control is necessary based on the information indicating a printing environment. However, Helterline teaches a system which stores the printer driver version number in a printer cartridge and updates said printer driver in the event that printing parameters changes during operation of the printing system (see Helterline col 6, lines 30-55). Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 5, lines 55-65; col 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward in order to update the printer drivers or other parameters and ensure that the printing system prints the highest quality images, as taught by Helterline.

As per claim 81, Meade fails to teach the method according to claim 69, wherein the information indicating a printing environment includes cartridge ID which is stored a memory element on the cartridge. However, Helterline teaches storing printer driver parameters such as printer driver number and other parameters in a printer cartridge memory (see Helterline col 6, lines 45-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine

the necessary users support information, as taught by Hayward in order to update the printer drivers or other parameters and ensure that the printing system prints the highest quality images, as taught by Helterline.

As per claim 82, Meade fails to teach:

The method according to claim 69, further comprising:

determining whether an update of the software for control is necessary based on the information indicating a printing environment;

transmitting the software for control from the information-providing server to the client if as a result processing to determine whether update is necessary it is found that update is necessary. However, Helterline teaches a system which stores the printer driver version number in a printer cartridge memory and updates said printer driver in the event that printing parameters changes during operation of the printing system (see Helterline col 6, lines 30-55). Hayward teaches a system that detects computers' peripherals conditions and provides user support based upon said detection (see column 5, lines 55-65; col 6, lines 20-57). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Meade would transmit to a remote server computers peripheral conditions to determine the necessary users support information, as taught by Hayward in order to update the printer drivers or other parameters and ensure that the printing system prints the highest quality images, as taught by Helterline.

6. Claims 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Helterline et al (U.S. 6,039,430) in view of Hayward et al (U.S. 6,629,134).

As per claims 83 and 84, Helterline teaches:

A system which uses a host apparatus and image-forming apparatus that are connected to each other and a server to which the host apparatus is communicably connected, comprising:

a replaceable cartridge with a memory element is attached to the image-forming apparatus (see col 4, lines 7-12);

first information including a cartridge type are stored in the memory element of the cartridge (see col 6, lines 45-55);

the image-forming apparatus comprises a first memory region for storing second information in connection with a first computer program in regard to image forming, a first reading component for reading the first information from the memory element of the cartridge (see col 6, lines 15-55), a second reading component for reading the second information from the first memory region (see col 5, line 53 – col 6, line 55) and the host apparatus comprises a receiving component for receiving the first information and the second information (see col 8, lines 39-45), a second memory region for storing second program type information in connection with a second computer program in regard to driving the image forming apparatus, a first determining component for determining whether an update of the first computer program is necessary based on the cartridge type in the first information and the second information (see col 6, lines 15-53), a second determining component for determining whether an update of the second computer program is necessary based on the cartridge type in the first information and the second program type information (see col 6, lines 15-55), but fails to teach that the

first information includes a URL for the server an access component for accessing the server indicated by the URL by using the URL if as a result processing to determine whether update is necessary it is found that update of at least one of the first an second computer program is necessary. However, Hayward teaches a system that benefits from the use of peripheral indicia, such as serial number and peripheral conditions to specify a URL address that exactly matches the user's peripheral conditions and uses said URL address to update the periphery software (see Hayward col 7, lines 55-65). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Helterline would use the printer cartridge parameters stored in the printer's cartridge memory in order to specify a URL address, as taught by Hayward which would allow the updating of the printer cartridge parameters such as printer's driver versions in order to ensure that the printing system prints the highest quality images, as taught by Helterline.

Response to Arguments

7. Applicant's arguments with respect to claims 6-8, 12-14, 16, 18, 19, 22, 23, 30, 31, 34, 35, 53, 55 and 57-84 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL
Daniel Lastra
July 23, 2006


RETTA YEHDEGA
PRIMARY EXAMINER